

REMARKS

All the claims submitted for examination have been objected to and /or rejected.

Applicants have amended their claims and respectfully submit that all the claims currently in this application are patentable over the objections and rejection of record.

Turning first to the objections of record, Claim 5 stands objected to because of the redundant recitation of two members of the Markush group recited in that claim. Specifically, phthalic acid and benzene tricarboxylic acid are recited twice as members of the organic acid within the contemplation of the composition of the present application. This redundant recitation has been deleted.

The second objection concerns Claim 19. Claim 19 is objected to for the redundant recitation of arylcarboxylic acid in the recitation of the Markush group of the organic acid of that method claim. The redundant recitation of arylcarboxylic acid has been deleted.

The claims of the present application have been rejected on formal and substantive grounds. The sole formal ground of rejection is directed to all the claims currently in this application, Claims 1 to 20, which stand rejected, under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The basis for this formal rejection is the recitation, in independent Claims 1, 12 and 18, of the presence of the organic acid in an amount of 0.125 wt.% or greater, based on the total dry weight of the polymeric binder. The Official Action states that there is no support in the originally filed application for this limitation.

Applicants have deleted the unsupported phrase, the predicate for this ground of rejection, and have replaced the offending phrase with the recitation that the organic acid is present in an amount of 0.5 to 5 parts per 40 parts of polymeric binder on a dry weight basis

overcomes the formal rejection of record. Attention is directed to the originally filled specification, at Page 10, lines 2-4, where support for this replacing recitation is specifically set forth. Applicants submit that this amendment to independent Claims 1, 12 and 18 overcomes the formal ground of rejection.

All the claims submitted for examination in this application, Claims 1 to 20, have been rejected on substantive grounds, under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent 6,004,725 to Barr et al.

The Official Action avers that Barr et al. teaches a negative-acting photoimagable composition useful in manufacturing printed circuit boards. That composition, set forth in the Example, comprises 12.49 wt % of Binder A' having an acid number of 239; 38.89 wt % of Binder A" having an acid number of 149; 9-phenyl acridine; and 0.06 wt% of o-phthalic.

The Official Action argues that these concentrations yields a concentration of 0.117 wt % of o-phthalic acid based on the total dry weight of Binders A' and A". Since 0.117 wt % is very close to the lower range of the organic acid concentration, 0.125 wt %, Barr et al. renders the claimed range of organic acid in the claimed photoresist composition obvious.

The stoichiometric calculation provided in the Official Action is correct. So too is the argument raised in support of the obviousness rejection. That is, applicant does not argue with the conclusion that if the organic acid concentration of the photoresist composition of the present application possessed a minimum organic acid concentration of 0.125 wt %, the proposition that the Barr et al. example presents a *prima facie* case of obviousness might be well taken. However, applicant's amendment of independent Claims 1, 12 and 18, wherein the concentration of the organic acid is recited to be an amount of from 0.5 to 5 parts per 40

parts of polymeric binder, clearly distinguishes the composition of the present application from that of Barr et al.

As amended, the organic acid is present in a concentration in the range of between 0.5 and 5 parts per 40 parts of polymeric binder on a dry weight basis. As such, the concentration of organic acid is in the range of 1.25 weight % and 12.5 weight % based on the total dry weight of the polymeric binder. Thus, as amended, the lower limit of organic acid concentration of the claimed photoresist composition is more than an order of magnitude greater than the concentration of organic acid employed in the Barr et al. photoresist composition.

This extreme difference in concentration of organic acid is easily explained insofar as Barr et al. discloses that the use of the organic acid, which in the Barr et al. composition is o-phthalic acid, is as an anti-oxidant. Obviously, the concentration required to provide anti-oxidant properties is far lower than the concentration required in the claimed composition of the present application wherein the non-polymerizable organic acid component is employed to impart photoresist strippability or removability. As indicated in the specification of the present application, at Page 8, lines 18-26, the organic acid must be present in adequate concentration to provide sufficient acid functionality to effectuate the advantages of the photoresist composition of the present application providing improved strippability over photoresist compositions of the prior art. Clearly, photoresist strippability is not provided by the Barr et al. composition wherein the acid concentration is far too low to impart this property. Indeed, Barr et al. provides no teaching, nor makes no allegation, that the composition of that disclosure has improved strippability. That the summary, provided in the

table at Column 5 in Barr et al. denoted as “Example,” categories o-phthalic acid as an anti-oxidizer establishes the irrelevance of the Barr et al. disclosure.

This point should not be underestimated. That is, the presence of o-phthalic acid as an anti-oxidizer in Barr et al. substantiates applicant’s argument that the Barr et al. teaching of a photoresist composition including an organic acid in very low concentration does not present a *prima facie* case of obviousness of the claims of the present application. An organic acid concentration in a photoresist composition of 0.06 wt %, as taught by Barr et al, although adequate as an anti-oxidant, it is clearly insufficient to provide the photoresist composition with easy strippability.

Applicant appreciates that the amendments made herein are made after final rejection. However, an Amendment after final rejection, which places an application in condition for allowance, is grounds for entrance of that Amendment. So it is in the prosecution of the present application. The amendment to the claims of the present application clearly places this application in condition for allowance. Entrance of the instant Amendment under 37 C.F.R. §1.116 is therefore deemed appropriate. Such action is respectfully urged.

The above amendment and remarks establish the patentable nature of all the claims

currently in this application. Notice of Allowance and passage to issue of these claims,
Claims 1-20, is therefore respectfully solicited.

Respectfully submitted,



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